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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/507,217

09/16/2004

Olivier Acher

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06/12/2006

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EXAMINER

COLILLA, DANIEL JAMES

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/507,217	ACHER, OLIVIER	
	Examiner	Art Unit	
	Daniel J. Colilla	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-86 is/are pending in the application.
- 4a) Of the above claim(s) 66-76 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-58 is/are allowed.
- 6) ☒ Claim(s) 59,62-65 and 77-82 is/are rejected.
- 7) ☒ Claim(s) 60,61 and 83-86 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/12/05, 11/10/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 31-39, 51-53, 58 and 66-76 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/17/06.

2. Claim 30 is generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 31-39, 51-53 and 58, directed to other species are no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim. However, claims 66-76 directed to other species remain withdrawn from consideration since they do not depend upon or otherwise include all the limitations of an allowed generic claim as required by 37 CFR 1.141.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 60 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 60, line 4, applicant recites the phrase, "after a cutting operation to be performed." The scope of the claim is rendered vague and indefinite because it is not clear if

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applicant is or is not reciting a cutting operation as part of the method. The term “after” suggests that applicant is reciting a cutting operation such that the step of determining portions to be weakened is a step that occurs subsequently to the step of cutting. However applicant’s use of the term “to be” suggests that a cutting operation is not positively being recited and is merely a statement of desired use. Correction and/or clarification is required.

Claim 61, line 4 has a similar problem.

Claim 65, line 3 also has a similar problem.

Withdrawn claim 76, also has a similar problem.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 59, 63-65 and 81-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baron (US 6,945,645) in view of Landa (US 6,004,421).

With respect to claim 59, Baron discloses the claimed method except that Baron is silent on whether the printing pattern corresponds to a multi-page document. Baron discloses a method including the steps of determining a printing pattern for application on a printable sheet using a CPU 24, monitor 23 and printer 30 as disclose in col. 2, lines 48-55. In col. 3, lines 34-46, Baron discloses a step of determining a target cutting pattern 26. Since Baron teaches the method using CPU 24, the system must inherently have a computer readable medium containing program

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instructions of for execution on the CPU 24 causing the CPU to perform the above mentioned steps. The target cutting pattern 26 identifies areas on the printable sheet as shown in Figure 2. Determining a printing patter corresponding to a multi-page document is extremely well-known as is shown in Figures 1-4 of Landa. Landa teaches printing a pattern over several pages to form a multi-page document (Landa, col. 2, line 36-64). It would have been obvious to combine the teaching of Landa with the method disclosed by Baron for the advantage of printing larger documents or images that do not fit on a smaller sheet stored in the printer.

With respect to claim 63, in claim 5, lines 11-16, Baron discloses that he scoring actuator facilitates separation of the media along the score pattern. Since the scoring actuator facilitates or makes easier, this is considered to be ergonomic and thus the cutting pattern is based on ergonomomy.

With respect to claim 64, Figure 3 of Baron shows a printed object 25 surrounded by score lines 26. Thus the printing pattern is a function of the target cutting pattern.

With respect to claim 65, paragraph [0034] discloses that the printing pattern identifies areas 29A of the at least one printable sheet to be eliminated as shown in Figure 5 of Baron.

With respect to claim 81, Baron discloses the computer system instructing a peripheral device 93 connected to the computer system for applying a first ink on the printable sheets as shown in Figure 9 of Baron.

With respect to claim 82, in col. 6, lines 15-19 Baron discloses the computer system including multiple printheads for color printing. While Baron does not expressly disclose instructing the peripheral device to apply a second ink on the areas of the printable sheet; it

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would have been obvious to one of ordinary skill in the art to use the available plural ink jet heads to apply ink for the advantage of having an aesthetically pleasing multicolor document.

7. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baron (US 6,945,645) in view of Landa (US 6,004,421) as applied to claim 59 above, and further in view of Osawa (JP 7-329371).

Baron in view of Landa discloses the claimed method on a computer readable medium except for the step of determining the target cutting pattern as a function of mechanical characteristics of the printable sheets. However, Osawa teaches determining a cutting pattern based on cutters such as the ones shown in Figure 6 of Osawa based on the mechanical characteristics of the print media such as kind, width, color, and contents of printing media. It would have been obvious to combine the teaching of Osawa with the computer readable medium disclosed by Baron in view of Landa for the advantage of enabling appropriate cutting of various printing media by selecting cutter among several cutters.

8. Claims 77-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baron (US 6,945,645) in view of Landa (US 6,004,421) as applied to claim 59 above, and further in view of MacDonald (US 2002/0113986).

With respect to claims 77-78, Baron in view of Landa discloses the claimed computer readable medium except that they are silent on whether the document can be a financial document. However, MacDonald teaches a method of cutting a bill (invoice) along a perforation line as disclosed in paragraph [0043] of MacDonald. It would have been obvious to combine the

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teaching of MacDoanld with the computer readable medium disclosed by Baron in view of Landa for the advantage of allowing the receiver of the bill to easily separate a payment coupon that the receiver is to return with his payment.

With respect to claim 79, MacDonald also discloses printing advertisements in paragraph [0043].

9. Claim 80 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baron (US 6,945,645) in view of Landa (US 6,004,421) as applied to claim 59 above, and further in view of Steenstra *et al.* (US 2005/0258594).

Baron in view of Landa discloses the claimed computer readable medium except that they are silent on whether the document can be a game. However, Steenstra *et al.* teaches a game that is perforated as mentioned in paragraphs [0071], [0074] and [0076]. It would have been obvious to use the computer readable medium as disclosed by Baron in view of Landa for producing the game taught by Steenstra *et al.* for the advantage of an automated cutting device for efficiently producing perforations.

Allowable Subject Matter

10. Claims 30-58 are allowed.

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11. Claims 60-61 and 83-86 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

Claims 30, 40-50 and 54-57 have been indicated as containing allowable subject matter primarily for the peripheral device including a first print head and a second print head; the second print head supplied by an absorbent ink cartridge and the lower power laser that emits a laser beam with a wavelength absorbed by locations marked with the absorbent ink; the power of the laser being sufficient to cut the paper sheet at the inked locations.

Claim 60 has been indicated as containing allowable subject matter primarily for the step of causing a computer system to carry out the step of determining portions of the at least one printable sheet to be weakened, without being cut through, after a cutting operation.

Claim 61 has been indicated as containing allowable subject matter primarily for the step of causing a computer system to carry out the step of determining locations of interruptions in the target cutting pattern so as to maintain said at least one printable sheet in a single piece even after a cutting operation.

Claim 83-86 have been indicated as containing allowable subject matter primarily for the step of the computer system instructing the peripheral device to direct a light onto the areas of the printable sheet where the second ink is applied.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 7, 2006



Daniel J. Colilla
Primary Examiner
Art Unit 2854